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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,499	08/31/2000	Motoi Otsuka	00625/LH	3671

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EXAMINER
ORTIZ, BELIX M

ART UNIT	PAPER NUMBER
2175	5

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No. ●	Applicant(s)
Office Action Summary	09/652,499	OTSUKA, MOTOI
	Examiner	Art Unit	
	Belix M. Ortiz	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>2</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>4/5/2004</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 22-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 22-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1. In response to communications files on 5-April-2004, claims 2-21 are cancelled;

the specification of the disclosure, and claim 1 is amended and new claims 22-24

have been added per applicant's request. Therefore, claims 1, and 22-24 are

presently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by

Beitel et al. (U.S. patent 4,430,728).

As to claim 1, Beitel et al. teaches a portable terminal which prestores

first and second identification information to limit use of a portable data storage

medium, that prestores third and fourth identification information, the portable

terminal (see abstract and column 2, lines 49-68) comprising:

first determining means for comparing the third identification information

stored in the data storage medium with the first identification information stored in

the portable terminal, and for determining based on a result of the comparison

whether access to the data storage medium is allowed (see column 1, lines 61-

66 and column 2, lines 61-63); and

second determining means, responsive to the first determining means

determining that the access to the data storage medium is allowed, for reading

the fourth identification information prestored in the data storage medium, for

comparing the read information with the second identification information

prestored in the terminal, and for determining based on a result of the

comparison whether access to data in the data storage medium in allowed (see

column 1, lines 65-67; column 2, lines 1-2; and column 2, lines 63-68);

wherein the data storage medium further prestores a software

application corresponding to the fourth identification information (see column 2,

lines 57-60);

wherein the portable terminal further comprises means, responsive to the

second determining means determining that the access to the data storage

medium is allowed and responsive to the terminal being instructed to start up the

software application, for comparing the fourth identification information

corresponding to the software application with the second identification

information, and for starting up the software application based en a result of the

comparison (see column 2, lines 49-68);

wherein the data storage medium further prestores a data file accessible through the software application (see column 2, lines 57-60); and

wherein the portable terminal further comprises means for accessing the data file based on the starting up of the software application stored in the data storage medium (see column 9, lines 64-68 and column 10, lines 1-7).

As to claim 24, Beitel et al. teaches a system comprising:

a portable storage medium (see column 2, lines 57-60);

a portable terminal is which the portable storage medium is connectable (see column 3, lines 61-65); and

a server that writes various codes and software to the data storage medium and the portable terminal (see column 5, lines 52-53);

wherein the server comprises:

means for storing hardware identification code unchangeably on the portable terminal and the portable data is storage medium in order to set the portable terminal and the portable data storage medium in corresponding relationship (see column 5, lines 17-25; column 9, lines 20-27; and column 9, lines 41-53);

means for storing on the portable terminal unchangeably a software identification code corresponding to a software application to be operated on the portable terminal (see column 5, lines 48-53); and

means for storing on the portable data storage medium a plurality of

software applications operating on the portable terminal, a plurality of data files

created by the plurality of software applications, respectively, a plurality of

software identification codes for the plurality of software applications,

respectively, and a plurality of user passwords for specifying a plurality of users,

respectively, who are able to use the data storage medium (see column 1, lines

50-61 and column 9, lines 41-53).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Beitel et al. (U.S. patent 4,430,728) in view of Tolopka et al. (U.S. patent

6,044,349).

As to claim 22, Beitel et al. teaches a system comprising:

a portable data storage medium (see column 2, lines 57-60); and

a portable terminal to which the data storage medium is connectable (see

column 3, lines 61-65);

wherein the portable data storage medium has stored thereon a plurality of software applications operable on the portable terminal, a data file created by each of the software applications, a hardware identification cede for identifying the data storage medium, a plurality of software identification codes for the plurality of software applications, respectively, and a plurality of user passwords for specifying a plurality of users, respectively, that are able to use she data storage medium (see column 5, lines 17-25; column 9, lines 20-27; and column 9, lines 41-53),

wherein the portable terminal comprises a non-rewritable storage area in which a hardware identification code for specifying the portable terminal and a plurality of software identification codes each for identifying available software applications are stored, and a rewritable storage area (see figure 5, character "500" and column 5, lines 48-53); and

wherein the portable terminal further comprises:

means, responsive to a power supply being turned on when the portable data storage medium has been connected to the portable terminal, for reading the hardware identification code stored on the data storage medium and then determining whether or not the read hardware identification code matches the hardware identification code stored in the non-rewritable storage area of the portable terminal (see column 4, lines 5-15); and

means, responsive to determining that the read identification code matches, for determining whether or not a password inputted by a user who

operates the portable terminal matches any one of the plurality of passwords for specifying the plurality of users, respectively, stored in the data storage medium (see column 1, lines 50-61 and column 9, lines 41-53);

Beitel et al. does not teach means, responsive to determining that the inputted password matches, for allowing the user to select any desired one of the plurality of software applications stored on the data storage medium;

means, responsive to the user selecting the desired application software, for reading from the data storage medium a software identification code corresponding to the selected software application, and for determining whether or not the software identification code matching the read software identification code is stored in the non-rewritable storage area of the portable terminal; and

means, responsive to determining that the matching software identification code is stored, for starting up the selected software application stored on the data storage medium, and for storing on the data storage medium a data file created by operation of that application software as a data file corresponding to that application software.

Tolopka et al. teaches secure and convenient information storage and retrieval method and apparatus (see abstract) in which he teaches means, responsive to determining that the inputted password matches, for allowing the user to select any desired one of the plurality of software applications stored on the data storage medium (see column 3, lines 37-42);

means, responsive to the user selecting the desired application software, for reading from the data storage medium a software identification code corresponding to the selected software application, and for determining whether or not the software identification code matching the read software identification code is stored in the non-rewritable storage area of the portable terminal (see column 3, lines 37-42 and column 7, lines 59-63); and

means, responsive to determining that the matching software identification code is stored, for starting up the selected software application stored on the data storage medium, and for storing on the data storage medium a data file created by operation of that application software as a data file corresponding to that application software (see column 3, lines 47-52; column 3, lines 58-62; and column 6, lines 30-32).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Beitel et al. to include

means, responsive to determining that the inputted password matches, for allowing the user to select any desired one of the plurality of software applications stored on the data storage medium;

means, responsive to the user selecting the desired application software, for reading from the data storage medium a software identification code corresponding to the selected software application, and for determining whether or not the software identification code matching the read software identification code is stored in the non-rewritable storage area of the portable terminal; and

means, responsive to determining that the matching software identification code is stored, for starting up the selected software application stored on the data storage medium, and for storing on the data storage medium a data file created by operation of that application software as a data file corresponding to that application software.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Beitel et al. by the teaching of Tolopka et al., because means, responsive to determining that the inputted password matches, for allowing the user to select any desired one of the plurality of software applications stored on the data storage medium;

means, responsive to the user selecting the desired application software, for reading from the data storage medium a software identification code corresponding to the selected software application, and for determining whether or not the software identification code matching the read software identification code is stored in the non-rewritable storage area of the portable terminal; and means, responsive to determining that the matching software identification code is stored, for starting up the selected software application stored on the data storage medium, and for storing on the data storage medium a data file created by operation of that application software as a data file corresponding to that application software, would enable the system, because "a portable storage medium is used to store data and provide access to information from an information dissemination system (IDS). The storage medium can store one or

more location/key pairs. Each of the location/key pairs designates a particular

IDS location as well as an access key to the particular IDS location. The storage

medium can also store a plurality of information units", (see Tolopka et al.,

abstract).

"The storage medium can also store a plurality of information units. The

information units are categorized into levels of information categories with at

least one information category per level and at least one information unit per

information category. Levels of information categories can be individually

accessed and categories of information units within levels can be selectively

downloaded", (see Tolopka et al., column 2, lines 11-18).

As to claim 23, Beitel et al. as modified teaches wherein:

the portable data storage medium further stores basic software for driving

the portable terminal (see Beitel et al., column 2, lines 57-60); and

the portable terminal is responsive to the power source being turned on to

thereby be operated by the basic software for reading the hardware identification

information from the data storage medium, and for determining whether or not

the read hardware identification information matches the hardware identification

information stored on the portable terminal (see Beitel et al., column 4, lines 5-

15).

Response to Arguments

6. Applicant's arguments filed 5- April- 2004 with respect to the rejected claims in

view of the cited references have been fully considered but they are not found

persuasive:

In response to applicants' arguments that "Tolopka et al. fail to disclose,

teach or suggest the features of the portable terminal apparatus and portable

data recording medium is valid, and if the relationship is valid, both the portable

data storage medium and the portable terminal to which the data storage

medium and the portable terminal to which the data storage medium is

connected become usable", the arguments have been fully considered but are

not deemed persuasive, because Beitel et al. teaches "A portable memory

module or security key contains the secret telephone number of the called ·

telephone as well as the secret user identification code and selectively accesses

the first security circuit for activation thereof. When activated, the first security

circuit dials up the called telephone and transmits the user identification code to

the second security circuit. Upon verification, the second security circuit sends

an acknowledgment signal to the first security circuit. The security circuits

together then activate solid state switches to interconnect the remote computer

terminal to the host computer", (see Beitel et al., column 2, lines 56-68).

In response to applicants' arguments that "Tolopka et al. fail to disclose,

teach or suggest the features of the claimed present invention whereby in order

to determine the validity of the relationship in correspondence between the

portable terminal and the portable data storage medium, it is determined whether

or not the hardware ID stores on the connected data storage medium matches

the hardware ID stores unchangeably on the portable terminal and that when an

application is started after a match has been detected, it is determined whether

or not the software ID stored on the portable data storage medium matches the

software ID stored unchangeably on the portable terminal", the arguments have

been fully considered but are not deemed persuasive, because Beitel et al.

teaches "the computer terminal security system of the present invention provides

a solution to the problem and includes a first security circuit interconnected

with the calling telephone, the calling modem, and the remote computer terminal

all at the remote location. It also includes a second security circuit

interconnected with the called telephone, the called modem, and the host

computer at the location of the central host computer. A portable memory

module or security key contains the secret telephone number of the called

telephone as well as the secret user identification code and selectively

accesses the first security circuit for activation thereof. When activated,

the first security circuit dials up the called telephone and transmits the user

identification code to the second security circuit. Upon verification, the

second security circuit sends an acknowledgment signal to the first security

circuit. The security circuits together then activate solid state switches to

interconnect the remote computer terminal to the host computer", (see <u>Beitel et</u>

<u>al.</u>, column 2, lines 49-68)

"And the conventional remote terminal computer 130 accesses

the dialer/transmitter circuit 200 over lines 230. The dialer/transmitter 200

is activated by a memory module or security key 240 which is physically

inserted into the dialer/transmitter circuit 200 and which is graphically

represented by arrow 250", (see <u>Beitel et al.</u>, column 3, lines 59-65).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 703-305-7605. The examiner can normally be reached on moday-friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

bmo

May 26, 2004

SAM RIMELL
PRIMARY EXAMINER